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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,430	10/09/2001	Noel K. Hancock	10017267-1	6285
7590 08/08/2008 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			EXAMINER STERRETT, JONATHAN G	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 08/08/2008	DELIVERY MODE PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOEL K. HANCOCK,
ANDRE M. E. NEL, and
JEAN-CHRISTOPHE PAUTRAT

Appeal 2008-1278
Application 09/973,430
Technology Center 3600

Decided: August 8, 2008

Before HUBERT C. LORIN, JENNIFER D. BAHR, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Noel K. Hancock, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM but denominate the rejection as a new ground of rejection under 37 C.F.R. § 41.50(b) (2007).¹

THE INVENTION

The invention is directed to a method and a computer program on a computer-readable medium for benchmarking product samples provided to a purchasing entity from multiple independent suppliers. Claims 1 and 17 are illustrative of the claimed invention.

1. A method of benchmarking product samples provided to a purchasing entity by multiple independent suppliers, comprising:

collecting multiple sets of performance parameter values corresponding to results of testing each of the product samples at test facilities of each of the suppliers; and

generating an evaluation report based upon the multiple sets of performance parameter values.

17. A computer program for benchmarking product samples provided to a purchasing entity by multiple independent suppliers, the computer program residing on a computer-

¹ Our decision will make reference to Appellants' Appeal Brief ("Br.," filed Nov. 6, 2006) and the Examiner's Answer ("Answer," mailed Feb. 7, 2007).

readable medium and comprising computer-readable instructions for causing a computer to:

collect multiple sets of performance parameter values corresponding to results of testing each of the product samples at test facilities of each of the suppliers; and

generate based upon the multiple sets of performance parameter values an evaluation report comprising a data structure relating corresponding ones of the performance parameter values and respective ones of the test facilities for each of the product samples.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Kinra US 5,731,991 Mar. 24, 1998

Schoneker, David R.; "Changing the supply-chain controls for excipients – Part 1: The IPEC-Americas 'Certificate of Analysis guide for bulk pharmaceutical excipients", Jun. 2000, Pharmaceutical Technology, Vol. 24, Iss. 6, p.42, ProQuest ID 55656380. [Schoneker]

Stewart, Doug; "Suspicious for a living / behind the scenes with bumper bashers, dishwasher debunkers, chocolate chip chompers and condom demolition experts – the folks who test products for Consumer Reports", Oct. 1993, San Francisco Chronicle, Calif., p.7.Z.1, ProQuest ID 67113483. [Stewart]

"Welcome to the Performance Measurement Group, LLC", www.pmgbenchmarking.com, web.archive.org webpage of March 7, 2005, pp.1-4,

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web.archive.org/web/20001006043000/www.pmgbenchmarking.com/ps_pds_faqs.html. [PMG]

“General Motors Supplier Development – General Procedure: Evaluation and Accreditation of Supplier Test Facilities GP10”, Published by GM’s Supplier Development Administration, GM1796, Feb. 1990, pp. 1-19.

The following rejections are before us for review:

- Claims 1-4, 8-10, and 17-19 are rejected under §103(a) over Kinra;
 - Claim 5 is rejected under 35 USC §103(a) over Kinra and Schoneker;
 - Claims 6 and 7 are rejected under 35 USC §103(a) over Kinra and Stewart;
 - Claims 11-14 and 20 are rejected under 35 USC §103(a) over Kinra and PMG;
- and,
- Claims 15 and 16 are rejected under 35 USC §103(a) over Kinra and GP10.

ISSUES

The issues before us are whether the Appellants have shown that the Examiner erred in rejecting claims 1-4, 8-10, and 17-19 under §103(a) over Kinra; claim 5 under §103(a) over Kinra and Schoneker; claims 6 and 7 under §103(a) over Kinra and Stewart; claims 11-14 and 20 under §103(a) over Kinra and PMG; and, claims 15 and 16 under §103(a) over Kinra and GP10. These issues turn on whether the cited prior art would prompt one of

ordinary skill in the art to collect multiple sets of performance parameter values corresponding to results of testing each of a plurality of product samples at test facilities of each of a plurality of suppliers that test each product sample and generating an evaluation report based on those results.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 1 is drawn to a method of using product samples provided by multiple independent suppliers to a purchasing entity so as to benchmark them.
2. According to the Specification, “[p]roduct samples may be any product that the purchasing entity has an interest in evaluating, including any hardware product, software product and any firmware product.” Specification 5:22-24.
3. According to the Specification, “[p]urchasing entity 16 [Figs. 1 and 2] may be a manufacturer, such as an original equipment manufacturer, that produces complex equipment (e.g., computer systems) from component parts.” Specification 5:24-26.

4. The method of claim 1 recites two steps.
5. The first step of claim 1 calls for collecting multiple sets of performance parameter values corresponding to results of testing each of the product samples at test facilities of each of the suppliers.
6. The Specification (7:4-21) describes collecting multiple sets of performance parameter values as follows:

The actual testing that is performed at the test facilities of suppliers 18-22 will depend upon the nature of the products being tested. In general, industry-standard tests preferably are performed on the product samples under conditions that are substantially the same from one test facility to another. Multiple performance parameter values may be obtained from each testing facility for each product sample. In some instances, a performance parameter is determined for each product sample from a calculation involving multiple parameters. For example, with respect to CPU (central processing unit) product samples, the Gibson Mix test or the Dhrystone Benchmark test may be used to arrive at a single performance parameter value for each product sample. Both of these performance measures are concerned with the speed of a CPU. The Dhrystone Benchmark measures the speed of executing a given number of program statements on a CPU. The Gibson Mix refers to the mix of instructions used by a computer while executing scientific programs. The Gibson Mix is used as a workload model for a CPU. The Gibson Mix provides a weighted sum as the mix of a set of instructions. Storage systems, on the other hand, such as disk drives and random access memories, are functionally

different from processors, and a different set of performance parameters would be used to benchmark their performance.

7. The second steps calls for generating an evaluation report based upon the multiple sets of performance parameter values. “As shown in FIGS. 3A and 3B, the evaluation report may include a data structure 30 (e.g., a table) that relates performance parameter values and supplier test facility for each product sample under evaluation, and a graph 32 that displays some or all of the information contained in data structure 30.” Specification 8:5-8.

The scope and content of the prior art

8. Kinra relates to a system for evaluating software products.
9. Kinra describes an automated method for “evaluating software products based upon a plurality of predefined criteria” (col. 1, ll. 51-52). See also col. 5, ll. 6-8, and col. 9, ll. 47-48.
10. Schoneker is a copy of an article about improving the control of the supply chain for excipients to be used in pharmaceutical dosage forms.
11. According to the Examiner, Schoneker describes on “Page 4 paragraph 1 line 1-4, the user of material from a supplier (i.e. the purchasing entity) conducts their own tests on material provided by the supplier to establish the reliability of the supplier’s COA’s. ... Schoneker further teaches that this step is necessary to ensure the

supplied material meets specifications (line 4 paragraph 1).”

Answer 11.

12. Stewart is a copy of an article about testers.
13. According to the Examiner, Stewart describes on “Page 2 paragraph 6 line 1-4, a blind test is conducted with expensive perfume Page 3 paragraph 9 line 1-3, chocolate chip cookies are tested with only numbers assigned to them, in this example, a number “28” is assigned to a cookie being tested.” Answer 12 and 13-14.
14. PMG is a copy of a webpage from a website about product development benchmarking.
15. According to the Examiner PMG describes:
 - On “Page 2 paragraph 7 line 1-5, subscribers can access the benchmarking system to access the system.” Answer 15.
 - On “Page 2 paragraph 5 line, mini-presentations summarize the benchmarking results and comprise a report that is downloaded (i.e. transmitting).” Answer 15.
 - “Suppliers receiving a copy of an evaluation report allows them to compare their performance to that of other suppliers (page 2 paragraph 5 line 3-7).” Answer 15, 16, and 17.

- On “Page 2 paragraph 6 line 1-2, subscriptions (i.e. paying a fee that is collected) are sold for companies to buy the benchmarking services.” Answer 16.
 - On “Page 3 paragraph 2 line 2-6, the identity of other suppliers is removed so that company-specific data is not revealed.” Answer 17.
 - On “Page 2 paragraph 5 line 3-5, evaluation reports are customized for individual suppliers and provide a comparison of the supplier to average and best-in-class (BIC) for a particular metric.” Answer 18.
 - On “Page 3 paragraph 2 line 2-4, company data is kept proprietary by only showing metrics in aggregate, other than for BIC and avg. metrics... .” Answer 18.
16. GP10 is a copy of a General Motors procedure for evaluation and accreditation of supplier test facilities.
17. According to the Examiner GP10 describes:
- “[On] Page 17 Item B No. 5, product samples are identified and reports identifying the product samples are traced (i.e. tracked and recorded).” Answer 20.
 - “[On] Page 5, GP10 teaches that each facility is recorded and qualified as a supplier test facility. Standards are applied to these test facilities to ensure that different test facilities provide

as repeatable measurements across these different test facilities as possible (see also page 6 Item 6a where qualification of test equipment is discussed).” Answer 20.

- “[M]aintaining records and ensuring qualification for supplier test facilities is necessary to ensure traceability for supplier test results (page 17 Item B No. 5).” Answer 21.
18. The Examiner has taken “Official Notice ... that having test facilities at suppliers is old and well known in the art of supply chain management.” Answer 5 and 6.
 19. The Examiner has taken “official notice . . . that it is old and well known in the art of supply chain management for a purchasing entity of products to control the testing of said products including during testing at the test facilities of suppliers.” Answer 7.
 20. The Examiner has taken “official notice ... that it is old and well known in the art of supply chain management for a purchasing entity of products to control the testing of said products, including unauthorized access to product samples.” Answer 8.
 21. The Examiner has taken “Official Notice ... that it is old and well known in the art of measurement to test product samples according to substantially similar test conditions so that meaningful comparisons can be made.” Answer 9.

22. The Examiner has taken “Official Notice . . . that it is old and well known in the art of management that company data that reflects internal performance is considered sensitive and proprietary.”

Answer 18.

Any differences between the claimed subject matter and the prior art

23. No single cited reference explicitly describes collecting multiple sets of performance parameter values corresponding to results of testing each of a plurality of product samples at test facilities of each of a plurality of suppliers and generating an evaluation report.

The level of skill in the art

24. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent art of testing product samples. As such, we will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d. 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown.’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).
25. Those having ordinary skill in the art of testing product samples would have known, at the time of the invention, that test facilities

at suppliers (including suppliers of software products) are used to test a supplier's products as well as those of their competitors.

26. Those having ordinary skill in the art of testing product samples would have known, at the time of the invention, that suppliers (including suppliers of software products) provide product samples to a purchasing entity.

Secondary considerations

27. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). “[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am.*

Acad., 367 F.3d at 1364.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-4, 8-10, and 17-19 under §103(a) over Kinra.

The Appellants argued claims 1-4, 8-10, and 17-19 separately, as follows:

- Claim 1 (Br. 5-11);
- Claim 2 (Br. 11-13);
- Claim 3 (Br. 13-15);
- Claim 4 (Br. 15);
- Claim 8 (Br. 15); and,
- Claims 17-19 (Br. 15-16).

The Appeal Brief does not separately address claims 9 and 10. Accordingly they stand or fall on claim 1, the claim on which they depend.

Claim 1

The Examiner argued that Kinra describes all the claimed limitations except for “test facilities of each of the suppliers” (referring to the second claimed step of “collecting multiple sets of performance parameter values corresponding to results of testing each of the product samples”).

“However, Official Notice is taken that having test facilities at suppliers is old and well known in the art of supply chain management.” Answer 5. The Examiner determined that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kinra,

regarding providing evaluation of product samples to include the steps of providing evaluations of product samples at test facilities of each of the suppliers, because it would ensure products meet quality standards prior to being shipped from the supplier.” Answer 5.

The Appellants argued that the Examiner failed to give any patentable weight to the claim phrase “provided to a purchasing entity by multiple independent suppliers”. Br. 6. The Examiner responded by arguing that this phrase represented an intended use, set forth in the preamble, and did not deserve patentable weight. Answer 22.

Based on the broadest reasonable construction of claim 1 as it would be interpreted by one of ordinary skill in the art, claim 1 defines a method of using product samples provided by multiple independent suppliers to a purchasing entity so as to benchmark them. See FF 1-7. The claimed benchmarking process comprises the steps of collecting multiple sets of performance parameter values corresponding to results of testing *each* of the product samples at test facilities of *each* of the suppliers and generating an evaluation report. Accordingly, we agree with the Appellants that “properly construed, claim 1 requires collecting multiple sets of performance parameter values corresponding to results of testing each of the [product] samples provided to a purchasing entity by multiple independent suppliers at test facilities of each of the suppliers, and generating an evaluation report

based upon the multiple sets of performance parameter values.” Br. 8.
Emphasis original.

However, notwithstanding that the method of claim 1 calls for collecting values corresponding to results of testing *each* sample at test facilities of *each* supplier, the claim encompasses the Kinra method.

Kinra describes an automated method for evaluating software products based upon a plurality of predefined criteria. FF 9. The Examiner (Answer 4-5) argued that Kinra describes collecting “multiple sets of performance parameter values corresponding to results of testing each of the [product] samples” (though not at “at test facilities of each of the suppliers.”) The Examiner’s characterization of the scope and content of Kinra does not appear to be in dispute. It is therefore taken as correct.

The Appellants argued however that, notwithstanding what was known in the art (i.e., Kinra), “the mere knowledge that a product supplier typically tests its own products at its own facilities before shipping them does not lead to the conclusion that it would have been obvious to collect multiple sets of performance parameter values corresponding to results of testing each of the product samples provided to a purchasing entity by multiple independent suppliers at the test facilities of each of the independent suppliers.” Br. 9.

Accordingly, the Appellants take the position that, although Kinra describes an automated method for evaluating software products based upon

a plurality of predefined criteria, Kinra would not lead one of ordinary skill in the art to collect multiple sets of performance parameter values corresponding to results of testing *each* of the product samples provided to a purchasing entity by multiple independent suppliers at the test facilities of *each* of the independent suppliers.

We do not find the Appellants argument persuasive as to error in the rejection.

We agree with the Examiner that it is well known that suppliers (including suppliers of software products) have test facilities. It is further well known that suppliers (including suppliers of software products) provide product samples to a purchasing entity. Therefore, it would have been obvious to one of ordinary skill in the art to duplicate Kinra's automated method at various test facilities of suppliers of software products. Doing so would necessarily result in a "collect[ion] of multiple sets of performance parameter values corresponding to results of testing *each* of the product samples ... at the test facilities of *each* of the independent suppliers."

The next question is whether it would have been obvious to employ Kinra's automated method at each test facility of the suppliers of software products on *each of the software product samples provided to a purchasing entity by the suppliers*. This question turns on whether it was known in the prior art for a supplier to test not just their own products but that of other suppliers. In that regard, one of ordinary skill in the art would have known

that suppliers test competing products. FF 25. Given this, it would have been obvious to employ Kinra's automated method at each test facility of the suppliers of software products on *each software product samples provided to a purchasing entity by the suppliers*.

The Appellants also argued that the Examiner's motivation would not lead one of ordinary skill in the art to use Kinra's software. Br. 10-11. Specifically, the Appellants do not find that Kinra's software evaluation system would enable a supplier to qualify products to be of a certain standard prior to shipping. It remains necessary to show "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," but such reasoning "need not seek out precise teachings directed to the specific subject matter of the challenged claim." *KSR* at 1741. (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Kinra's method of giving software products criterion scores *would* enable a supplier to qualify components "so that the components are determined to be of a certain predetermined standard [prior to shipment]" (Br. 10-11). One of ordinary skill in the art would be led to do so in view of the facts that those having ordinary skill in the art of testing product samples would have known, at the time of the invention, that test facilities at suppliers (including suppliers of software products) are used to test a supplier's products, as well as those of their competitors, and provide product samples to a purchasing entity. FF 25 and 26.

We will sustain the rejection.

Claim 2

Claim 2 depends from claim 1. In arguing for claim 2, the Appellants repeated the arguments used against the rejection of claim 1. Br. 11-13. Accordingly, we rely on our earlier reasoning in reaching the same conclusion that the Appellants have not provided a persuasive argument as to error in the rejection of claim 2.

The Appellants also argued that the knowledge that a supplier would test its own products would not lead to a supplier testing other supplier's products. But, as we explained *supra*, suppliers often test competing products of other suppliers.

Claim 3

Claim 3 further defines the method of claim 2, and thereby claim 1, such that the testing “comprises the purchasing entity controlling the product samples during the testing at the test facilities of each of the suppliers.”

The Examiner conceded that Kinra does not describe control of product testing by the purchasing entity but took official notice that this was well known in the art of supply chain management. Answer 7. Appellants agreed that this is well known. Br. 14.

However, according to the Appellants, this does not render obvious a purchasing entity controlling products tested at each supplier.

We disagree. If a purchasing entity is known to control products tested at one supplier, then it would have been obvious for a purchasing entity to control products at all suppliers.

The Appellants also argued that Kinra describes access by users to product data and weighting values of the software product being evaluated, not access to the products being evaluated to control them. Br. 13-14. That is not a persuasive argument because the Appellants conceded that it is well known for a purchasing entity to control products tested at a supplier.

Claim 4

The Appellants relied on the arguments used against the rejection of claim 3. Br. 15. Accordingly, we rely on our earlier reasoning in reaching the same conclusion that the Appellants have not provided a persuasive argument as to error in the rejection of claim 4.

Claim 8

The Appellants relied on the arguments used against the rejection of claim 2. Br. 15. Accordingly, we rely on our earlier reasoning in reaching the same conclusion that the Appellants have not provided a persuasive argument as to error in the rejection of claim 8.

Claim 17-19

As to claims 17-18, the Appellants relied on the arguments used against the rejection of claim 1. Br. 15. Accordingly, we rely on our earlier reasoning in reaching the same conclusion that the Appellants have not provided a persuasive argument as to error in the rejection of claims 17-19.

As to claim 19, the Appellants relied on the arguments used against the rejection of claims 17-18 (Br. 16) and thus, for the same reasons we found the arguments relative claims 17-18 unpersuasive, we find the arguments unpersuasive as to error in the rejection of claim 19. Br. 16.

The rejection of claim 5 under §103(a) over Kinra and Schoneker .

The Appellants discuss the rejection of claim 5 at pp. 16-18 of the Brief. Claim 5 reads as follows:

Claim 5: The method of claim 3, wherein the testing comprises the purchasing entity maintaining custody of the product samples during the testing at the test facilities of each of the suppliers.

The Examiner relied on Schoneker to show as known a purchasing entity maintaining custody of products during testing. Answer 10-11. The Appellants argued that Schoneker describes custody of products at the purchasing entity, not at the suppliers. Br. 16-18.

We are not persuaded by the Appellants' argument. Since Schoneker shows a purchasing entity maintaining custody of products during testing, the claimed process amounts to combining this step with the known step of testing a product at a supplier. The result is predictable; i.e., a purchasing entity maintaining custody of products during testing at a supplier. There is therefore nothing unpredictable from making that combination to one of ordinary skill in the art and the Appellants have not shown an unexpected result from the combination that would contradict that conclusion. FF 27. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR* at 1739.

The rejection of claims 6 and 7 under §103(a) over Kinra and Stewart .

The Appellants discuss the rejection of claims 6 and 7 at pp. 18-20 of the Brief. Claims 6 and 7 read as follows:

Claim 6: The method of claim 2, further comprising removing identification information from the product samples before the testing at the test facilities of each of the suppliers.

Claim 7: The method of claim 6, wherein the removing comprises removing from each of the products any information from which the corresponding supplier of the product is identifiable.

In addition to the argument used against the rejection of claim 1 (which we find unpersuasive based on our earlier reasoning), the Appellants argued that one of ordinary skill in the art would not combine Stewart (which undisputedly describes removing identification from samples before testing) and Kinra (testing software) to arrive at the claimed invention. The Appellants took issue with the Examiner's rationale on the grounds that there is no reason to remove identification from the Kinra software products (i.e., there is no bias to remove). Br. 19.

We are satisfied that the Examiner has shown some articulated reasoning with some rational underpinning to support the prima facie case of obviousness. The Examiner argued that one of ordinary skill would remove identification so as to avoid bias in the testing. We find that logical. Kinra's product evaluation method is not dependent on knowing a product's identification. Nevertheless, one of ordinary skill in the art knows that an objective product evaluation requires removing any bias during testing. If it is known to remove identification as a precursor to objective testing, then it "is likely the product not of innovation but of ordinary skill and common sense." *KSR* at 1742.

The rejection of claims 11-14 and 20 under §103(a) over Kinra and PMG.

The Appellants argued claims 11-14 and 20 as a group (Br. 20-23). We select claim 11 as the representative claim for this group, and the remaining claims 12-14 and 20 stand or fall with claim 11. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Claim 11 reads as follows:

11. The method of claim 1, further comprising transmitting the evaluation report to one or more of the suppliers.

Appellants' argument focuses on the claim 11 limitation that the evaluation report is transmitted to a supplier. The Examiner relied on PMG to show suppliers receiving evaluation reports. Answer 14.

The Appellants argued that (a) PMG describes a different report than the one claimed, which is based on a collection of "multiple sets of performance parameter values corresponding to results of testing *each* of the product samples at the test facilities of *each* of the multiple suppliers;" (Emphasis added), (b) Kinra is concerned with generating an evaluation report of software to suppliers of the software and that this report is different from that of PMG and thus there is no reason to combine the two to reach the claimed invention, and (c) the Examiner has not pointed to anything in the references to provide motivation to combine. Br. 21-23.

The first two arguments are not persuasive as to error in the rejection because one of ordinary skill in the art, looking at Kinra alone, would

understand that a system of evaluation would include transmitting a report about the results of an evaluation. The Appellants conceded that Kinra generates an evaluation. Since, conventionally, an evaluation is often communicated by a report, it would have been obvious to combine Kinra's evaluation system and transmitting a report to suppliers. The result, predictably, is that suppliers receive a report of the results of the evaluation.

The last argument reflects a standard for determining obviousness akin to the rigorous application of the teaching, suggestion, or motivation (TSM) test that was prevalent at the time the brief on appeal was filed and before *KSR* issued (Apr. 2007). *KSR* clarified the test for obviousness, emphasizing “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussing circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *Id.* (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional approach” is “whether the improvement is more than the predictable use of prior art elements according

to their established functions.” *Id.* at 1740. Here, as we explained earlier, the claimed process amounts to a combination of known steps for their known functions that yields a predictable result. Accordingly, a *prima facie* case of obviousness has been established. Thus, the burden shifts to the Appellants to show otherwise. In that regard, no evidence of unexpected results has been provided that would require us to reconsider the underpinnings used to support the *prima facie* case of obviousness.

The rejection of claims 15 and 16 under §103(a) over Kinra and GP10.

The Appellants discuss the rejection of claims 6 and 7 at pp. 23-25 of the Brief. Claims 15 and 16 read as follows:

Claim 15: The method of claim 1, wherein the generating comprises compiling a data structure relating corresponding ones of the performance parameter values and respective ones of the supplier test facilities for each of the product samples.

Claim 16: The method of claim 15, wherein the generating comprises producing a graph displaying one or more performance parameter values for each of the product samples.

The question here is whether it would have been obvious to compile a data structure (e.g., a graph) relating performance parameter values and respective supplier test facilities for each product sample. To show this, the Examiner relied on GP10. Answer 20-21.

The Appellants do not explain why one of ordinary skill looking at GP10 would not generate a data structure from the claimed data. Regarding GP10, the Appellants (Br. 25) argued:

In addition, none of the sections of GP10 that are cited by the Examiner in support of the rejection of claim 15 would have led one skilled in the art to modify Kinra's disclosure to arrive at the invention recited in claim 15. Indeed, section B.5 on page 17 of GP10 merely asks the material test facility to "Describe how samples are identified and reports traced, and the questionnaire on pages 5 and 6 of GP10 merely asks a supplier to describe aspects of its test facility and testing policies.

We are not persuaded by this argument. The Appellants provide no explanation as to why a questionnaire asking about samples and a supplier's testing facilities would not have led one of ordinary skill to compile a data structure (e.g., a graph) relating performance parameter values and respective supplier test facilities for each product sample. This would appear to be a logical step in light of the objective of the questionnaire of ensuring uniformity among test facilities taught on page 2 of GP10. Accordingly, we will sustain the rejection.

CONCLUSIONS OF LAW

We conclude:

The rejections of claims 1-4, 8-10, and 17-19 under §103(a) over Kinra; claim 5 under §103(a) over Kinra and Schoneker; claims 6 and 7

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under §103(a) over Kinra and Stewart; claims 11-14 and 20 under §103(a) over Kinra and PMG; and, claims 15 and 16 under §103(a) over Kinra and GP10, are affirmed.

DECISION

The decision of the Examiner to reject claims 1-20 is affirmed.

AFFIRMED

vsh

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